



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,401	01/16/2002	Alfred Pollak	57361-1041	8318
35743 7590 03/06/2007 KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/06/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/06/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

<b>Office Action Summary</b>	Application No. 09/913,401	Applicant(s) POLLAK ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-28, 31, 33-42, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7, 11, 12, 16-20, 22, 41, 42 and 45 is/are allowed.
- 6) ☒ Claim(s) 6, 8-10, 13, 14, 21 and 23 is/are rejected.
- 7) ☒ Claim(s) 24-28, 31, 33-40 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 1/17/07 wherein claims 1, 4-10, 14, 16, 19-24, 26-28, 33-38, 45, and 46 are amended and claims 15, 29, 30, 32, 43, 44, and 47-49 are canceled.

**Note:** Claims 1-14, 16-28, 31, 33-42, 45, and 46 are pending.

## **COMMENTS/NOTES**

2. The following action is deemed necessary in order to further clarify some of the inconsistencies of the previously pending claims based on the amended of some of the claims.

## **RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS**

3. The Applicant's arguments and/or amendment filed 1/7/07 to the rejection of claims 1-14, 16-31, 33-42, and 45-49 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive for the reasons set forth below.

### **112 First Paragraph Rejections**

The 112, first paragraph, rejections are WITHDRAWN for reasons of record in Applicant's response filed 1/17/07.

### **112 Second Paragraph Rejections**

All outstanding 112, second paragraph, rejections are WITHDRAWN in light of the new grounds of rejections below. The new grounds of rejections were deemed necessary based on inconsistencies resulting from the amending of the claims

## NEW GROUNDS OF REJECTION

### **112 Second Paragraph Rejections**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 8-10, 13, 14, 21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6: The claim as written is ambiguous because one cannot ascertain what Applicant intends by the term 'small'. In particular, the term "small" in claim 6 is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 8 and 13: The claim as written contains improper Markush terminology. The term 'comprising' is not acceptable Markush terminology. Applicant is respectfully requested to review MPEP 803.02.

Claim 9: The claim as written is confusing. The ligand is 'a tetradentate N3S ligand or a polyamino polysulfide'; thus, the phrase 'comprises a peptide selected from the group consisting of...' is confusing because what are listed are ligands, not peptides.

Claim 10: The amended claim is confusing because it refers to claim 8 which has been amended to disclose that the targeting molecule is a peptide, polypeptide,

Art Unit: 1618

peptide mimetic, or organic molecule having a molecular weight of less than about 600 Daltons. However, claim 10 which depends on claim 8 discloses components present in the ligand, not the targeting molecule. Thus, it appears that the claim should be amended to refer to the ligand.

Claim 14: The claim refers to claim 5 and recites the limitation "the receptor or transporter" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 21: The claim is ambiguous because it is directed to preparing a metal ion labeled conjugate using the composition of claim 1, but does not disclose any steps for preparing the conjugate.

Claim 23: The claim as written is confusing because in claim 1, Applicant discloses that the conjugate comprises a ligand and a targeting moiety. Thus, the claim should read 'wherein the conjugate is a peptide and dimethylglycylserinylcysteinyl-glycine' since the two components of the conjugate are present.

#### **ALLOWABLE CLAIMS**

6. Claims 1-5, 7, 11, 12, 16-20, 22, 41, 42, and 45 are allowable over the prior art of record.

#### **CLAIM OBJECTIONS**

7. Claims 24-28, 31, 33-40 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1618

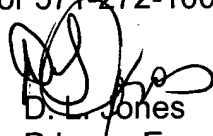
**ADDITIONAL NOTES/COMMENTS/SUGGESTIONS**

8. The claims are distinguished over the prior art of record for reasons for record in the office action mailed 10/19/06.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
D. L. Jones  
Primary Examiner  
Art Unit 1618

February 28, 2007